

Serial No. 10/824,203

Art Unit: 1616
Examiner: Luke E. KarpinskiREMARKS

In response to the Patent Office Action of April 2, 2010, the Applicant respectfully requests re-examination and reconsideration. To further the prosecution of this application, claims 15, 16, 40 and 41 have been canceled from the application and claims 9, 14 and 38 have been further amended. Claims 9 and 38 remain as the only independent claims. The Applicant also now files a Request for Continued Examination (RCE) in order to continue with the prosecution of this application.

Claims 40 and 41 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 40 and 41 have now been canceled from the application. Claims 9 and 38 have been amended to add the amphoteric surfactant, and accordingly the dependent claims 15 and 16 have been canceled. Claim 14 has also been amended to recite the amphoteric surfactant as including cocamidopropyl betaine.

On pages 4, 9 and 13 of the Patent Office Action a rejection has been presented by the Examiner. This rejection is based on 35 U.S.C. §103(a). This rejection is based primarily upon either Dawson et al alone or the combination of the Dawson et al. and Hall et al. references. In essence, the subject matter of the independent claims differs from Dawson et al or the combination, inter alia, in that:

- a) the present invention insures at least 4 minutes before gelling after adding the post-foaming agent;
- b) the present invention includes the presence of an amphoteric surfactant in addition to at least one anionic surfactant (Dawson does not teach the amphoteric surfactant);
- c) the composition of the present invention is stable for at least 12 months after manufacture in storage at 20°C to 25°C or below; and
- d) in accordance with the present invention the composition is added to the final package while not under pressure.

While Dawson mentions the gelling occurring up to 24 hours after adding the post-foaming agent, it also says that this is dependent upon the precise formulation. There is no

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evidence that Dawson has actually made a composition which can achieve this, as none of the examples give any hint that the gelling obtained is anything other than instant. If the gelling was delayed for any substantial length of time after adding the post-foaming agent, it is reasonable to presume that this would be mentioned in Dawson. The fact that it is not, is a clear indication that such a formulation was not actually made.

Additionally, if the degree of delayed gelling is dependent upon the precise formulation, there is no information given in Dawson regarding how the formulation can be changed from those in the examples to give them this delayed gelling property. The disclosure of Dawson is therefore insufficient regarding the teaching of a delayed gelling. Dawson thus provides no teaching regarding which constituents are required for a composition which can always ensure that no gelling occurs for at least 4 minutes after the addition of the post-foaming agent. Thus, in accordance with the present invention, the composition can always ensure that no gelling occurs for at least 4 minutes after the addition of the post-foaming agent as is set forth in the present independent claims.

Dawson et al, as acknowledged by the Examiner, does not teach the amphoteric surfactant, as claimed. The amphoteric surfactant, particularly in combination with the non-ionic gelling agent is theorized as responsible for the delayed gelling of the composition of the present invention. In this regard, refer to the present application on page 6 in the paragraph beginning at line 3 where this is set forth as an important feature of a composition of the present invention. The presence of the amphoteric surfactant, in particular, enables the composition of the invention to always ensure that no gelling occurs for at least 4 minutes after the addition of the post-foaming agent. As the disclosure in Dawson et al is insufficient with respect to how to change the example formulations to impart such a delayed gelling property, it is certainly also deficient with respect to how to always ensure that no gelling occurs for at least 4 minutes after the addition of the post-foaming agent.

According to MPEP §§ 2141(III) and 2142, to establish a prima facie case of obviousness, the claimed invention must have been obvious to one of ordinary skill in the art.

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Moreover, “[a]ll words in a claim must be considered in judging the patentability of the claim against the prior art.” MPEP § 2143.03 (quoting In re Wilson, 242 F.2d 1382, 1385 (C.C.P.A. 1970)). In support of an obviousness rejection, “the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” MPEP § 706.02(j) (quoting Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985)).

Applicant respectfully submits that the Examiner has not met the legal standard for 35 U.S.C. §103 obviousness rejection. To reject claims in an application under 35 U.S.C. §103, the United States Patent and Trademark Office (USPTO) bears the initial burden of establishing a *prima facie* case of obviousness.

In its recent decision of *KSR Int'l Co. v. Teleflex Inc.*, the United States Supreme Court rejected a narrow, rigid interpretation of the “teaching, suggestion, or motivation” (TSM) test by the Federal Circuit, under which a patent claim is only proved obvious if the prior art, the problem’s nature, or the knowledge of a person having ordinary skill in the art reveals some motivation or suggestion to combine the prior art teachings. The Court reaffirmed the standard of obviousness analysis as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2006). In *Graham*, it is required that the Examiner ascertain: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; and (3) the differences between the claimed subject matter and the prior art. *See* 383 U.S. at 1734. The obviousness or nonobviousness of the claimed subject matter must be determined in light of these inquiries. Moreover, the *Graham* Court also explained that secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc. might be utilized in determining the obviousness or nonobviousness of the invention.

It is necessary to note that the KSR Court has not abolished the TSM test. Rather, the Court held that the Court of Customs and Patent Appeals captured a “helpful insight” by establishing the requirement of demonstrating a teaching, suggestion, or motivation to combine

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known elements in order to show that the combination is obvious and that the Court merely rejected rigid and mandatory formulas during the application of the TSM test. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727. In fact, in a memorandum dated May 3, 2007 after the *KSR* decision, the USPTO interpreted the *KSR* decision as requiring any formulation of a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. Furthermore, the *KSR* Court also reaffirmed the holding in *Graham* that “secondary consideration as commercial success, long felt but unsolved needs, failure of others etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” See *Graham*, 383 U.S. at 17-18.

Following *Graham*, the Court of Customs and Patent Appeals (CCPA) and its present successor, the Court of Appeals for the Federal Circuit (CAFC), have hold the following considerations to be objective evidence of nonobviousness: long felt need, commercial success, failure of others, copying and unexpected results. See, e.g., *Avia Group Int'l Inc. v. L.A. Gear California, Inc.*, 853 F.3d 1557 (Fed. Cir. 1988); *In re Sernaker*, 702 F.2d 989 (Fed. Cir. 1983). In fact, the CAFC has consistently made clear that when evidence of such secondary considerations is present, it must be considered by the Examiner or a court in determining a question of obviousness. See e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-1380 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-1539 (Fed. Cir. 1983). Accordingly, it is the Applicant's position that the Examiner has to identify some reason why a person skilled in the art would have combined the Dawson et al and Lyle et al. reference. We find no such reasoning in the recent Office Action.

Now, with respect to the rejection presented by the Examiner, separately starting on respective pages 5 and 9 of the Patent Office Action, and relying upon the combination of Dawson et al. and Hall et al., it is the Applicant's position that this combination is improper in either instance. While the compositions of Hall et al. may comprise an amphoteric surfactant, the

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technical problem addressed by Hall et al. is the provision of a post-foaming gel composition for personal cleaning which feels good. Refer to Hall et al. at page 3, lines 1-3. This is a significantly different problem to that which is addressed by the present invention. In this regard a key objective of the present invention is to provide a gel structure of the composition that does not begin to form for a sufficient period of time during the processing and packing of the composition such that it can be easily pumped and filled into the packaging. In this regard, the aim of the present invention is to always ensure that no gelling occurs for at least 4 minutes after the addition of the post-foaming agent, and that thus the composition has long term storage stability.

Further, and significantly, Hall et al. details that the base material is already a gel even before the propellant/post-foaming agent is added. This is important in Hall et al. Thus, in Hall et al. there is definitely no teaching regarding how to guarantee a delayed gelling for at least 4 minutes after addition of a post-foaming agent to a composition. Moreover, Hall et al. is deficient as to any teaching that an amphoteric surfactant is the solution to ensure this delayed gelling. Thus, when one skilled in the art has an objective of solving an issue of ensuring that the gelling is always delayed for at least 4 minutes after the addition of a post-foaming agent to the composition, the Hall et al. reference is not the document to consult in that, in Hall et al., the composition is already in gel form before the post-foaming agent is even added.

So, it cannot be said that a skilled person would, without inventive skill, take the teaching from a document (Hsll et al.) that clearly does not achieve the aim of the problem being addressed, select one specific feature (the amphoteric surfactant) from it out of all of the other possible alternative components, and then combine this feature with the composition of Dawson et al., in the expectation that this would solve the problem of guaranteeing that the gelling is delayed for at least 4 minutes after addition of a post-foaming agent. This clearly would not be the obvious steps to take from the combination of these references.

Arguing that Hall et al. provides the amphoteric surfactant feature missing from Dawson et al. and so renders the present claims as non-inventive is nothing more than pure hindsight

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analysis in the knowledge of the actual solution. Hall et al. is just a document about a cleansing composition which happens to contain a component which is missing in Dawson et al.. It bears no relevance to the technical problem being addressed, and the amphoteric surfactant feature taken from Hall et al. has no bearing on any possible solution to the technical problem; and as such Hall et al. cannot be correctly used in the assessment of the problem. Furthermore, even if the skilled person were to combine Dawson et al. and Hall et al. (which they would not) there is no logical reason to specifically select an amphoteric surfactant out of all of possible components to combine with Dawson et al in the expectation of solving the problem.

In connection with the rejections set forth by the Examiner commencing on page 13 of the Patent Office Action, further reliance is also made on Anderson et al., and Sisbarro. Anderson discloses a delayed foaming gel product formed when the post-foaming agent is mixed with an aqueous surfactant. However, this foaming gel product is unstable under ambient conditions, though just stable enough to be exposed to ambient conditions for a short period of time before it is packaged, as long as the components are first chilled to near freezing temperatures before being mixed. There is therefore no teaching regarding how to guarantee a delayed gelling for at least 4 minutes after the addition of a post-foaming agent, as the compositions are simply not stable enough for this to happen.

Regarding the Sisbarro reference, this discloses a post-foaming gel where the composition forms a gel before it is added to a filling machine for introduction into a container. There is therefore no teaching regarding how to guarantee a delayed gelling for at least 4 minutes after the addition of a post-foaming agent.

One passage on page 17 of the Official Action states that "references are not required to teach each and every problem." No, but they are required to at least try and solve the problem the invention addresses if they are to be considered as prejudicial to the invention. If they do not even do this, then how can it be that an invention is "obvious" when starting from a document which does not even address the same problem, or which even teaches away from the problem.

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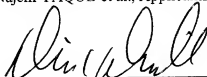
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In view of the foregoing amendments and remarks, the Applicant respectfully submits that all of the claims pending in the above-identified application are in condition for allowance, and a notice to that effect is earnestly solicited.

If the present application is found by the Examiner not to be in condition for allowance, then the Applicant hereby requests a telephone or personal interview to facilitate the resolution of any remaining matters. Applicant's attorney may be contacted by telephone at the number indicated below to schedule such an interview.

The U.S. Patent and Trademark Office is authorized to charge any fees incurred as a result of the filing hereof to our Deposit Account No. 19-0120.

Respectfully submitted,
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